

REMARKS

The Examiner is requiring restriction to one of the following groups:

Group I: Claims 1-18, drawn to (a) oxide particles, (b) toner, and (c) an image forming apparatus; and

Group II: Claims 19 and 20, drawn to an image forming process.

Applicants have elected Group I, claims 1-18 and 21, drawn to (a) oxide particles, (b) toner, and (c) an image forming apparatus, with traverse.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples, to support any conclusion in regard to patentable distinctness (M.P.E.P. § 803). Applicants respectfully traverse the restriction requirement on the grounds that the Examiner has not carried the burden of providing sufficient reason and/or examples to support any conclusion that the claims of the restricted groups are patentably distinct.

The Examiner has classified Group I(b) and Group II as product and process of use. Patentable distinctness may be shown if either or both of the following can be shown: (A) that the process of using the product as claimed can be practiced with another materially different product or (B) that the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). The Examiner asserts that the product as claimed may be used in a materially different process, such as a process that does not require transferring the toner image to a recording medium as required in the processes of Group II.

However, the Examiner's assertion does not meet the requirements under § 806.05(h), because a mere generalization that one of the features of the inventions may be excluded is not evidence that the claimed product can be used in a materially different process of using

the product. Therefore, the Examiner's reasoning is merely a restatement of the Examiner's conclusion that the two groups are patentably distinct, which is improper.

The Examiner has classified Group II and Group I(c) as process and apparatus for its practice. Patentable distinctness may be shown under M.P.E.P. § 806.05(e), as discussed above. The Examiner asserts that the process can be practiced by hand, and lists process steps that she alleges can be performed by hand.

The Examiner's assertion, however, does not meet the requirements under § 806.05(e), since it is not evidence the claimed image-forming process can be performed by hand. In particular, the Examiner has not shown that merely performing any of the process steps by hand would result in any objectives of the claimed invention. Therefore, the Examiner's reasoning is merely a restatement of the Examiner's conclusion that the two groups are patentably distinct, which is improper.

The Examiner has classified Group I(a) and Group II as unrelated. Patentable distinctness may be shown if different groups are not disclosed as capable of use together, and have different modes of operation, different functions or different effects. (M.P.E.P § 806.04; M.P.E.P § 808.01). According to the Examiner, the Groups I(a) and II have different functions and different effects, since Group II is drawn to an image forming method and Group I(c) is drawn to oxide particles.

However, the Examiner's assertion is not evidence that the groups are unrelated, since the process of Group II includes the "oxide fine particles" that are also recited in Group I(a). As such, the Examiner has not met the requirements under §§ 806.04 and 808.01. Therefore, the restriction is improper.

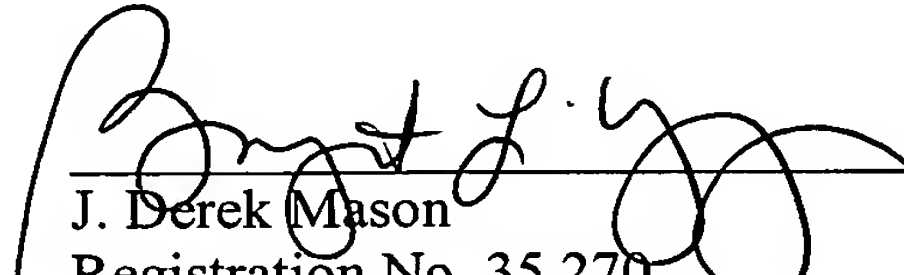
Accordingly, for at least the reasons presented above, Applicants submit that the Examiner has failed to meet the burden necessary to sustain the restriction requirement.

Application No. 10/618,640
Reply to Office Action of July 22, 2005

Withdrawal of the requirement is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


J. Derek Mason
Registration No. 35,270

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220

Bryant L. Young
Registration No. 49,073